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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,839	03/11/2002	Hubertus Burkhardt	4211-10PUS	2545

7590 01/22/2003

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EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
1731	5

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,839

Applicant(s)

BURKHARDT, HUBERTUS

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17 2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- 1) Acknowledgement is made of Preliminary Amendment received 3///2002, Paper No. 4. Applicant cancels claims 1-9, and offers new claims 10-19, for consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 2) Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Schmid (4,717,502). Schmid discloses an optically brightened coated paper. Said paper includes a coating placed on top of a base paper (col. 3, lines 22-26). The base paper is made of cellulosic fibrous material, e.g. from wood fibers (col. 6, lines 1-7). The coating includes a binder, white pigment, water, dispersing and antifoaming agents, and an aqueous brightener comprising of a derivative of diaminostilbene disulfonic acid as disclosed by Schmid in formula II (col. 3, line 28 to col. 6, line 68). It is inherent that the brightener is located on top of the coating layer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) Claims 11-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid in view of Peters (WO 90/01581). Schmid is applied as above for claim 10, Schmid fails to disclose additional coatings. Peters discloses additional coatings 1 and 2, with the optical brightener being on the top coating (Peters, Pgs. 7-11). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Schmid and Peters, because such a combination would provide a more effective coating in the design of Schmid.

4) Claims 13-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Schmid.

Claim 13: Peters discloses a method of producing an optically brightened printing paper wherein a paper web is first coated with a protective coating and then dried, where after the optical brightener is added to the coated paper and subsequently dried (Peters, pgs, 7-19). Peters fails to disclose that the optical brightener added is a derivative of diaminostilbene disulfonic acid. Schmid discloses a process of making a brightened coated paper wherein a coating is placed on top of a base paper (Schmid, col. 3, lines 22-26), wherein the base paper is made of cellulosic fibrous material, such as, wood fibers (Schmid, col. 6, lines 1-7), and wherein the coating includes an aqueous brightener comprising of a derivative of diaminostilbene disulfonic acid as disclosed by Schmid in formula II (col. 3, line 28 to col. 6, line 68). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of

Peters and Schmid, because such a combination would expand the scope of brighteners available in the design of Peters.

Claims 14-15: Peters discloses roll application of the brightener solution (pg. 19, line 3).

Claims 16-17: Peters discloses spray application of the brightener solution (pg. 18, line 32).

Claim 18: Peters discloses coating machine application of the brightener solution (pg. 18, lines 30-33).

Claim 19: Peters discloses calendering application (pg. 18, lines 18-20).

Conclusion

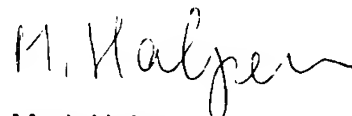
5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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A handwritten signature in black ink, appearing to read "M. Halpern", with a stylized flourish at the end.

Mark Halpern
Patent Examiner
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January 21, 2003